

## **REMARKS**

### **Amendments**

Applicants gratefully acknowledge the Examiner's indication that the compounds of Formulas III and VI are allowable. Claim 1 is amended to be directed to the compounds of Formulas III and VI. Claims 2, 5, 45-49, and 55-57 are amended to be consistent with the language of amended claim 1. Also, as a result of these amendments, claims 3, 4, 6, 7, 9-13, 29-44, 50-53, and 78 are cancelled.

Additionally, claim 60 is amended to recite a method for treating a patient suffering from memory impairment due to certain diseases/conditions, i.e., the diseases/conditions recited in claims 65, 66, and 76. As a result of these amendments, claim 66, 68, and 76 are amended and claims 63, 64, 67, and 70 are cancelled. Also, method claims 69 and 71-75 are cancelled.

### **Rejection under 35 USC 112, first paragraph, written description**

Claims 60-77 are rejected on grounds of the specification allegedly failing to provide written description of the claimed invention. Applicants respectfully disagree.

To satisfy the written description requirement, an applicants' specification need only reasonably convey to one of ordinary skill in the art that applicants had possession of the claimed subject matter as of the filing date of the application. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991).

Initially, the rejection argues that no biological assays are performed. Performing biological assays and/or reporting the results thereof are not necessary to establish a written description of an invention. Such is not needed to convey possession of the claimed subject matter, and the rejection cites no authority in support of the allegation. Next, the rejection asserts that effecting PDE4 inhibition and treating diseases involving decreased cAMP levels are not practical utilities. This is a conclusory statement and an unsubstantiated assertion.

The rejection then alleges that the claims are deemed to be reach-through claims. Again, this is a conclusory statement.

At the end of the rejection, it is alleged that the rejection can be overcome if the method claims are amended to recite the diseases listed in claims 65 and 76-77. As noted above, claim 60 is amended to recite the diseases/conditions recited in claims 65, 66, and 76.

In any event, the rejection fails to present any reasons why the specification fails to reasonably convey that applicants' had possession of the invention recited in claim 60 at the time the application was filed. Withdrawal of the rejection is respectfully requested.

**Rejection under 35 USC 112, first paragraph, enablement**

Claims 60-77 are rejected on grounds that the specification allegedly fails to provide enablement of the claimed invention. This rejection is respectfully traversed.

The Examiner argues that Martin et al. disclose that clinical trials on certain drugs had been stopped because of "lack of selective inhibition of PDE4 and other factors." The rejection further argues that the "predictability of the efficacy of any PDE4 inhibitor is therefore very suspect." But, these arguments fail to suggest that the compounds discussed in the Martin et al. article were not inhibitors of PDE4 or did not have activity in the treatment of diseases resulting from PDE4. It is the providence of the FDA, not the PTO, to be concerned with issues of drug safety and/or lack of undesirable side effects. See, e.g., *In re Anthony*, 162 USPQ 594 (CCPA 1969). Moreover, the arguments do not in any way suggest that applicants claimed compounds lack activity.

It is also argued that aging is a natural process and that there are no known treatments for aging. Claim 76 does not recite a method for the general treatment of aging, but instead recites the treatment of memory impairment due to aging.

The rejection further argues that not all diseases arising from increased PDE4 and/or decreased cAMP are known. This is mere speculation and further is irrelevant. For example, consider a claimed method for preventing infection of a wound by covering the wound with a protective bandage. Such a method would not somehow become non-enabled if a new bacteria was discovered that would cause an infection, were it not for the protective bandage.

As for the assertion of undue experimentation, performing assays is clearly a routine practice and well within the ken of one ordinary skill in the art.

At the end of the rejection, reference is made to the Examiner's previous suggestion regarding claim amendments. As noted above, claim 60 is amended to recite the diseases/conditions recited in claims 65, 66, and 76.

In view of the above remarks, it is respectfully submitted that one of ordinary skill in the art, in view of the guidance e provided by applicants' disclosure, would be objectively able to practice the claimed methods using no more than routine experimentation. Nothing more is required under the statute. Withdrawal of the rejection is respectfully requested.

**Rejection under 35 USC 112, second paragraph**

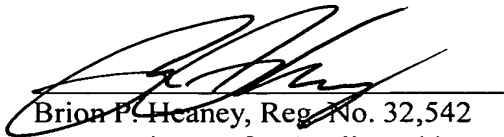
Claims 60-77 are rejected on grounds that the language of the claims is allegedly indefinite. This rejection is respectfully traversed. The rejection merely states that the claims are indefinite "for the reasons set forth above." However, the rejections under 35 USC 112, first paragraph, present no rationale as to why one of ordinary skill in the art would be unable to determine whether a given embodiment was within or outside the literal scope of the claims.

As for claim 65, this claim recites the treatment of memory impairment due to certain diseases, not the treatment of diseases that are caused by memory impairment. Moreover, claim 65 is amended to depend from claim 60, rather than cancelled claim 64.

Withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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